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IN THE

Supreme Court of the United States

OCTOBER TERM 1961

No. [redacted] 135

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,

Petitioner,

—v.—

ALLEN B. DU MONT LABORATORIES, INC.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

FLOYD H. CREWS
Attorney for Respondent
405 Lexington Avenue
New York 17, New York

DARBY & DARBY
Donald J. Overocker
Gordon D. Coplein
405 Lexington Avenue
New York 17, New York
Of Counsel

June 22, 1962

LAWYERS PRESS, INC., 214 William St., N. Y. C. 38; Phone: BEekman 3-2300

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No. 993

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,

Petitioner,

—v.—

ALLEN B. DU MONT LABORATORIES, INC.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION

Opinions in This Case

1. The opinion of the District Court granting the motion to substitute the Executrix, the widow of the original plaintiff, is reported at 154 F. Supp. 368 (D. Del., June 21, 1957, Judge Layton).

2. The opinion of the District Court denying Respondent's (Du Mont's) motion for summary judgment of invalidity of the six patents originally in suit, including patent 2,133,642 ('642), is reported at 166 F. Supp. 332 (D. Del., Sept. 12, 1958, Judge Layton).

3. The opinion of the District Court holding all five patents then in suit, including certain claims of the '642

patent, invalid for double patenting, after a full trial on the merits, is reported at 178 F. Supp. 84 (D. Del., Sept. 15, 1959, Judge Layton).

4. Du Mont's petition for certiorari (October Term, 1960, No. 611) on the question of survival was denied by this Court at 365 U. S. 816 (Feb. 20, 1961).

5. The opinion of the Court of Appeals affirming the District Court is reported at 297 F. 2d 323 (3d Cir., Nov. 29, 1961).

Additional Questions Presented

In the event certiorari is granted in this case the following additional questions should be considered:

1. Did the District Court have jurisdiction of the case—that is, does a cause of action for past patent infringement survive the death of the patent owner?

2. Is the patent in suit invalid over the prior art?

3. Is the patent in suit invalid because the claims are vague, indefinite and functional?

4. Are claims 64, 65 and 66 of the patent in suit invalid because there is no disclosure to support them?

5. Has the patent in suit been infringed?

6. Is the patent in suit unenforceable because it has been misused?

Counter Statement of the Case

1. Pierce's statement is badly garbled, incomplete, in part misleading, and in part factually erroneous.

2. On July 19, 1954 George Washington Pierce, the original plaintiff, sued Du Mont for infringement of six patents including the single surviving patent No. 2,133,642 (not 2,113,642). That patent (herein called '642) issued on October 18, 1938 and therefore expired on October 18, 1955 (2b).*

3. After its expiration George Washington Pierce died on August 25, 1956 (1a).*

4. A motion to substitute his Executrix (his widow) was opposed by Du Mont but was granted by Judge Layton in Opinion No. 1 above, which is reported at 154 F. Supp. 368 (D. Del., June 21, 1957). The opposition was on the ground that a cause of action for past infringement of a patent does not survive the death of the patentee.

5. A full trial of the action was held before Judge Layton beginning on March 24, 1959. At the trial Du Mont made a motion to dismiss on the ground of non-survival of the cause of action. The motion was denied.

6. Judge Layton, after a complete trial and full briefs, held all claims in suit, of all five patents, invalid. This included one group of claims of the '642 patent which he held

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* Du Mont's Appendix in the Court of Appeals (a separate document) has page numbers followed by the suffix "b". Pierce's appendix was bound with her brief and has page numbers followed by "a".

invalid for double patenting over the earlier Pierce patent 1,789,496 (herein '496), which issued on Jan. 20, 1931 (24b).

7. Judge Layton did not pass on the question of whether that group of claims was (1) invalid over the prior art; or (2) whether those claims were invalid because vague, indefinite and functional; or (3) whether claims 64, 65, and 66 were also invalid because there is no disclosure to support them; or (4) whether any claim had been infringed; or (5) whether the patent was unenforceable because it had been misused.

8. On the appeal Pierce dropped all patents except '642, and restricted the appeal to claims 3, 24, 40, 51, 52, 54-56 and 61-68 of the '642 patent. All of these claims were in the group that had been held by Judge Layton to be invalid for double patenting over the '496 patent.

9. The Court of Appeals held that a cause of action for patent infringement does survive the death of a patent owner. It also held all appealed claims to be invalid for double patenting over the '496 patent, without passing on any of the defenses raised in questions 2 to 6 above.

10. On page 4 of the Petition, Pierce says:

> "The three Courts of Appeals for the First, Third and Fifth Circuits are agreed that this Pierce oscillator constituted a patentable invention."

11. The First and Third Circuit Courts of Appeals have held the '642 patent invalid for double patenting over the '496 patent. The Fifth Circuit Court of Appeals has not decided the merits of the patent. Any statement that Pierce chooses to interpret as any such "agreement" is dictum.

12. The '642 patent has been held invalid in the following actions:

Case 1: *American Communications Co. Inc.* v. *Pierce*, 208 F. 2d 763 (1st Cir. 1953); cert. denied 347 U. S. 944 (1954); rehearing denied 347 U. S. 970 (1954); reversing *Pierce* v. *American Communications Co., Inc.*, 111 F. Supp. 181 (D. Mass. 1953, Judge Ford).

Case 2: *Pierce* v. *Hewlett-Packard Co.*, 125 F. Supp. 329 (D. Mass. 1954, Judge Wyzanski); affirmed 220 F. 2d 531 (1st Cir. 1955); cert. denied 350 U. S. 833 (1955); rehearing denied 350 U. S. 897 (1955).

Case 3: *Pierce* v. *American Communications Co. Inc.*, and *Pierce* v. *Mackay Radio & Telegraph Inc.*, 159 F. Supp. 943 (D. Mass. 1958, Judge Ford), affirmed 280 F. 2d 278 (1st Cir. 1960); cert. denied 364 U. S. 902 (1960).

Case 4: *Pierce* v. *Aeronautical Communications Equipment, Inc.*, Order of Judge Choate granting summary (and final) judgment (S. D. Florida, Miami Division No. 5638-M Civil, 1957); case reversed and remanded for further proceedings, without passing on the merits. 255 F. 2d 458 (5th Cir. 1958). Second decision 198 F. Supp. 269 (S. D. Fla., 1961, Judge Gourley).

13. In these cases, referred to below by case number as listed above, the following claims of the '642 patent were held invalid for double patenting over the earlier '496 patent.

Case 1: Claims 51, 52, 54, 55, 56 and 61-68, inclusive.

Case 2: Claims 51, 52, 54-56 and 61-68 inclusive.

Case 3: All of the claims of the patent except claims 105 and 106 which were held invalid as being vague and there being insufficient disclosure in the patent to support them.

Case 4. All of the claims of the patent in the first decision.

(This was in the District Court. The Court of Appeals did not pass on the question of validity.)

Claims 51, 52, 54, 55 and 61-68 in the second District Court decision.

14. All of these decisions in Cases 1 to 4 above, were on motions for summary judgment or appeals therefrom. In Cases 1 to 3 this Court has denied certiorari on the question here presented.

15. On page 4 of the Petition, Pierce says:

"Each of the said Courts of Appeals further agrees that at one time Dr. Pierce tried to issue his Pierce oscillator element claims in the same patent as the co-operative transmitter-and-receiver combination claims, but that the Patent Office refused to permit this to be done."

16. This statement is wrong as to the Third Circuit Court of Appeals. All of the other cases were decided on motions for summary judgment and Pierce falsely represented this to be a fact before all of those Courts. Judge Layton made a similar statement in his Opinion (No. 2 above) in this case on Du Mont's motion for summary judgment, 166 F. Supp. 332 (D. Del. 1958), based on Pierce's misrepresentation to him that this was a fact.

17. In the present case the facts were fully presented at the trial, and both Judge Layton and the Court of

Appeals expressly held to the contrary. Judge Layton said in a footnote on 7a:

> "I have carefully reviewed the evidence on this point and conclude that there was no formal demand, or requirement, for a division."

and on page 15a:

> "* * * it is reasonably clear that no official action was entered by the Patent Office requiring a division;"

and again on page 29a:

> "Rines, seeing that he would either have to divide or suffer a final rejection by the Examiner and appeal therefrom, voluntarily divided."

18. The Court of Appeals in the present case adopted and quoted from Judge Layton's findings just quoted. (See footnote at page 22 of the Petition.)

19. The application for the '642 patent was first allowed with broad claims on Sept. 3, 1929, more than a year before the '496 patent issued on Jan. 20, 1931. The Court of Appeals said at Petition, page 22:

> "But this is not the present case. Here, the inventor, by merely paying his final fee could have obtained his generic patent more than a year before he actually obtained the narrower patent '496. He made a considered election to postpone his acquisition of the broader monopoly until he was sure that its exploitation would not be hampered by conflicting claims of a rival inventor."

and again on the same page:

> "This, therefore, is not a case where administrative action prevented the inventor from having his more

comprehensive application patented first, but rather where the choice has been the inventor's, dictated by his own judgment of possible economic advantage."

20. Pierce says on page 4 of the Petition:

"Each of said Courts of Appeals additionally agrees that the Patent Examiner requested Dr. Pierce's attorney to file a separate divisional application for the cooperative transmitter-and-receiver combination."

21. There is no support for this statement. The Patent Office never "requests" anybody to file a patent application and has no authority to do so.

22. On page 6 of the Petition, Pierce says:

"The Court of Appeals for the Fifth Circuit disagreed with the Court of Appeals for the First Circuit, 255 F. 2d 458 (Appendix B, pp. 34, 35)

'plaintiff did make a significant contribution with the Pierce oscillator, he is entitled to the patent on it *alone* to prevent its use without his consent *in any combination* and for the full 17 years.' (emphasis added)"

23. What the Court of Appeals for the Fifth Circuit held was that the District Court had not given the case adequate consideration in deciding it on the motion for summary judgment, and sent it back for further proceedings not inconsistent with its opinion. The sentence quoted in part from Appendix B, pp. 34, 35, actually appears on page 35 and begins with these words: "If, as appears to be undisputed, the * * *". On remand the District Court in its second decision (Case 4 above) held all claims then in suit of the '642 patent invalid for double patenting over

'496 (198 F. Supp. 269). This second decision is not mentioned in the Petition.

24. At the bottom of page 6 Pierce gives a partial quotation from Judge Layton's Opinion (No. 2 above) on Du Mont's motion for summary judgment in this case at 166 F. Supp. 332 (1958). The full quotation at 166 F. Supp. 335 is as follows:

> "In the face of the contrary results arrived at by the First and Fifth Circuit Courts, should defendant's motion be granted?
>
> "[1] I am impressed by the fact that it is strongly probable that Prof. Pierce has made a significant contribution with the Pierce oscillator. If this be so, he is entitled to a patent on it carrying with it all the protection to which an inventor is entitled for the full seventeen years of the life of the patent. It was not his fault that he was required to split his original application into several parts."

25. It will be noted that Pierce omitted the words "it is strongly probable" and "If this be so". She also omitted the entire last sentence which says that Judge Layton based his decision in part on the misrepresentation that had been made to him as to a Patent Office requirement for division.

Argument

The Question Presented by Pierce

Pierce asserts (Petition, p. 2) that the decision below "constitutes brand new law as to which no authority is even cited, and which is diametrically opposite to all prior decisions of the Supreme Court."

This is incorrect. The Court below cited earlier decisions of the Supreme Court (Petition, pp. 18-19), of the First

(Petition, p. 21), Seventh, D. C., and Sixth Circuit Courts of Appeals, the Court of Customs and Patent Appeals, and the Patent Office (Petition, p. 19), in support of its decision. There is no conflict with this or any other Court.

Pierce asserts conflict with the Fifth Circuit Court of Appeals decision in Case 4 above (pp. 5-6). As stated above, that Court of Appeals did not pass on validity. On remand the District Court again held the claims in suit of the '642 patent invalid for double patenting over the '496 patent. This decision on remand, not mentioned in the Petition, shows there is no conflict between the Third and Fifth Circuits.

Pierce asserts that the decision below creates confusion as to the status of combination and element patents. We know of no such confusion, and the authority cited by the Court below shows that there is no such confusion. Pierce gives no examples of confusion, and cites no cases showing any confusion.

The only cases cited by Pierce are *United States* v. *American Bell Telephone Co.*, 167 U. S. 224, 247 (1896) and *Leeds & Catlin Company* v. *Victor Talking Machine Company*, 213 U. S. 301, 319 (1909).

The *Telephone* case has nothing to do with the question. All the Court said there was that Congress could have fixed a different period for the life of a patent. No question of double patenting was involved.

The *Leeds & Catlin* case is equally pointless. There was no double patenting question in the case.

The Questions Presented by Du Mont Above

If certiorari should be granted, Question No. 1 presented above by Du Mont should be answered first as it goes to jurisdiction. This question was separately briefed and argued below in advance of the argument on the merits, but decision was withheld until after final argument. Before the argument on the merits the question was presented to the Supreme Court in a petition for writ of certiorari filed by Du Mont, in the October Term 1960, No. 611. At that time certiorari was denied, 365 U. S. 816 (1961).

The other questions presented above should either be decided by the Supreme Court or sent back for decision by the lower courts in the event the Court below should be sustained as to jurisdiction (survival) and reversed as to double patenting. These questions were all presented to both Courts below, who found it unnecessary to decide them in view of the other grounds for decision in Du Mont's favor.

CONCLUSION

It is accordingly prayed:

1. That the Petition be denied.

2. That if the Petition be granted Du Mont's Question No. 1 be decided first as a preliminary question.

3. That if the petition should be granted and Du Mont's Question No. 1 be answered in the affirmative and Pierce's question in the negative, then Du Mont's Questions Nos. 2 to 6 be decided by this Court, or the case remanded with instructions that they be decided by the Courts below.

Respectfully submitted,

FLOYD H. CREWS
Attorney for Respondent
405 Lexington Avenue
New York 17, New York

DARBY & DARBY
Donald J. Overocker
Gordon D. Coplein
405 Lexington Avenue
New York 17, New York
Of Counsel

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